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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,160	12/28/2000	Anthony B. Eoga	PA00-1010-Y	8687

7590 12/06/2001

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EXAMINER
ANTHONY, JOSEPH DAVID

ART UNIT	PAPER NUMBER
1714	2

DATE MAILED: 12/06/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/751,160	Applicant(s)
	Examiner	Group Art Unit 1714

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-26 is/are pending in the application.

Of the above, claim(s) 15-26 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-14 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-15, drawn to a composition, classified in class 252, subclass 182.12

II. Claims 16-26, drawn to a method of coating and product by process, classified in class 427, subclass 384.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product or composition as claimed can be used in a materially different process, such as one in which the composition is extruded into a free-standing sheet.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

5. This application contains claims directed to the following patentably distinct species of the claimed invention:

a) where the composition is polyethylene oxide and water (Claims 1 and claims dependent on Claim 1);

b) where the composition is a water soluble ether and water (Claim 2 and claims dependent on Claim 2).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the

limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. During a telephone conversation with Steven Stein on November 6, 2001 a provisional election was made WTHOUT traverse to prosecute the invention of Group I and species a) (polyethylene oxide), claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-26 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention and species.

Emma Cameron
AU 1762

DETAILED ACTION

Claim Rejections - 35 USC § 102 & 103

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-4, 6, 8, 10-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Sramek U.S. Patent Number 4,861,583.

Sramek teaches aqueous hot curling hair treatment compositions that comprise polyethylene oxide polymers that have a molecular weight between 20,000 to about 250,000.

Applicant's claims are deemed to be anticipated over the examples, see especially examples 1 and 15.

4. Claims 5, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sramek U.S. Patent Number 4,861,583.

Sramek has been described above. Sramek differs from applicant's claimed invention in that there is no direct teaching (i.e. by way of an example) to composition that actually contain an anionic surfactant, a coloring agent or where the polyethylene oxide has a density of about 0.5 grams/ml.

It would have been obvious to one having ordinary skill in the art to use the disclosure of Sramek as motivation to make aqueous compositions that further comprises anionic surfactant and coloring agents. This is obvious because both anionic surfactant and coloring agents come within the broad disclosure of the reference. Furthermore, such components are notoriously well known in the art to be used in such compositions. Finally, applicant's claimed polyethylene oxide density of about 0.5 grams/ml is deemed to be met by using polyethylene oxide polymers that have a molecular weight between 20,000 to about 250,000 as disclosed by Sramek, or is deemed to be met by the polyethylene oxide polymer used in comparative example 15.

5. Claims 1, 3-4, 6, 8, 11-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Park U.S. Patent Number 5,750,269.

Park teaches removable aqueous coating composition that comprise oxidized polyethylene wax, and process for protecting surfaces. Applicant's claims are deemed to be anticipated over example 1.

6. Claims 1-4, and 11-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Maggiolo U.S. Patent Number 3,632,422.

Maggiolo teaches textiles fabric soil release finishing compositions. Applicant's claims are deemed to be anticipated over example 1.

7. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maggiolo U.S. Patent Number 3,632,422.

Maggiolo has been described above. Maggilol differs from applicant's claimed invention in that there is no direct teaching (i.e. by way of an example) to finishing compositions that actually contain a coloring agent or a fragrance. It would have been obvious to one having ordinary skill in the art, using Maggiolo as motivation, to make finishing compositions that actually contain a coloring agent or a fragrance since such additional components come within the broad disclosure of the patent and are so well known in the art.

8. Claims 2-3, 5, and 9-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Murayama U.S. Patent Number 5,401,495.

Murayama teaches teeth whitener compositions. Applicant's claims are deemed to be anticipated over Example 4.

9. Claims 2-3, 5, and 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sintov et al. Patent Number 5,425,953.

Sintov et al. discloses aqueous polymer compositions for tooth bleaching and other dental uses. The composition can comprise from about 5% to 15% by weight of hydroxypropyl cellulose, see the abstract, examples and claim 10.

Sintov et al. differs from applicant's claimed invention in a number of ways such as: 1) there is no direct teaching (i.e. by way of an example) to an aqueous composition that actually comprises hydroxypropyl cellulose within applicant's claimed concentration range., and 2) the use of additional agents such as a coloring agent, an anionic surfactant, or a fragrance are not directly taught (i.e. by way of an example).

It would have also been obvious to one having ordinary skill in the art to use the disclosure of Sintov et al as motivation to actually make thickened aqueous dental compositions that contain a concentration of hydroxypropyl cellulose that reads on applicant's claimed amount since such concentrations are directly disclosed by the patent, see claim 10. It would have also been obvious to one having ordinary skill in the art to use the disclosure of Sintov et al as motivation to actually make thickened aqueous dental compositions that contain an anionic

surfactant, a coloring agent or a fragrance since such are deemed to come with the broad disclosure of the patent and are also so well known in the art to be used in such compositions.

10. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jennings, Sr. U.S. Patent Number 3,956,951.

Jennings, Sr. discloses dry and aqueous shaving compositions that comprise polyethylene oxide polymers directly within applicant's disclosed molecular weight range. Jennings, Sr. differs from applicant's claimed invention in that there is not a direct teaching (i.e. by way of an example) to an aqueous composition that contains polyethylene oxide. Furthermore, the addition of other components such as anionic surfactant, coloring agents, and fragrances are also not direct taught by way of an example.

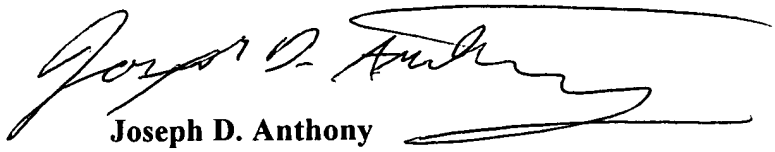
It would have been obvious to one having ordinary skill in the art to use the broad disclosure of Jennings, Sr. as motivation to actually make an aqueous shaving composition that contained polyethylene oxide polymer. The further addition of anionic surfactant, coloring agents or fragrances is also deemed to come within the broad disclosure of the references and are in any case notoriously well known in the art.

Prior-Art Cited But Not Applied

11. Any prior-art reference which is cited on FORM PTO-892 but not applied, is cited only to show the general state of the prior-art at the time of applicant's invention.

Examiner Information

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (703) 308-0446. This examiner can normally be reached on Monday through Thursday from 7:35 a.m. to 6:00 p.m. in the eastern time zone. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The group FAX machine number is (703) 305-5408. The group FAX machine numbers are (703) 305-5408, (703) 305-7718, and (703) 305-5433. Unofficial correspondence transmitted by FAX must be marked "DRAFT". All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0651. The receptionist is located on the 8th floor of Crystal Plaza 3 (e.g. CP-3) and will be the welcome point for all visitors to the building.



Joseph D. Anthony
Primary Patent Examiner
Art Unit 1714

12/3/01